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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,641	06/08/2001	Juan Luis Benitez-Vargas		9339

7590
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03/04/2009

EXAMINER	
MILLER, BRANDON J	

ART UNIT	PAPER NUMBER
2617	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/877,641

Applicant(s)

BENITEZ-VARGAS, JUAN LUIS

Examiner

BRANDON J. MILLER

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/IC)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendments/Remarks

Disposition of Claims

- I. Claims 1-4 are pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

II. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1,148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- III. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Rydbeck (US Pat. 5,590,417) in view of Weatherill (US 5,881,149).

Regarding claim 1 Rydbeck discloses a system for hands-free wireless cellular phone use (Abstract) comprising: an earset including a ear hanger and an earphone (headset 110, ear clip 160, earphone 140, [col. 3, lines 28 - 38, Fig.7]), a microphone (microphone 150, Fig. 7)

designed to be positioned over a user's mouth (col. 3, lines 3 - 8, col. 4, lines 66 - 67, col. 5, lines 1 - 11, Fig. 7), and a receptor/transmitter unit capable of receiving and transmitting signals of a specific wavelength (FM receiver 210, FM transmitter 205 communicate over short distance [col. 3, lines 39 -48, Fig. 4a]), the receptor/transmitter unit electronically connected to the earphone and microphone (FM receiver 210, coupled, via audio amplifier 220, to speaker 140 and FM transmitter 205 coupled to microphone 150, [col. 3, lines 39 - 48, lines 65 - 67, col. 4, lines 1 - 7, Fig. 4a] or Transceiver 207 coupled to microphone 150 [col. 4, lines 66 - 67, col. 5, lines 1 - 11, Fig. 4b]) the earset designed to be worn over a user's ear, the earphone designed to be positioned over an ear of a user (ear clip 160, col. 3, lines 28 - 38, Fig. 7), a cellular phone (portable telephone unit 100 [col. 2, lines 56 - 67, col. 3, lines 1 - 2, Fig. 2c]); a universal plug (transceiver 255, Fig. 6) electronically connected to the cellular phone (portable telephone unit 100 [col. 5, lines 56 - 67, col. 6, lines 1 - 3, Fig. 2c]) capable of receiving and transmitting signals of a specific wavelength (col. 3, lines 39-48); wherein a user would be able to use the earset to communicate with another individual through the cellular phone (col. 1, lines 46 -56). Rydbeck does not specifically teach the earphone having a volume control connected directly to the earphone. Weatherill teaches an earphone having a volume control connected directly to the earphone (see col. 1, lines 66-67, col. 2, lines 1-4, col. 4, lines 58-60, col. 5, lines 3 & 7-8, and FIGS. 1A-1D). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the earphone device in Rydbeck adapt to include a volume control connected directly to the earphone as taught in Weatherill because the earphone volume control in Weatherill can be implemented in the earphone in Rydbeck which would allow for more

convenient control over communication functions. The combination of Rydbeck and Weatherill arrives at the claimed invention.

Regarding claim 2, as applied to claim 1, Rydbeck further discloses wherein the receptor/transmitter unit and the universal plug uses the same wavelength (col. 3, lines 39 - 48).

Regarding claims 3 and 4, as applied to claim 2, Rydbeck further discloses wherein words spoken into the microphone of the earset (headset 110, Fig. 2c) or words spoken by another individual in communication the cellular phone (portable telephone unit, 100, Fig. 2c) are converted to radio signals of a specific wavelength (col. 3, lines 39 - 48) wherein the signals are then wherein the signals are then transmitted and amplified by the receptor/transmitter unit (FM transmitter 205, Fig. 4a) unit in the earset (headset) to the universal plug (transceiver 255, Fig. 6), wherein the universal plug (transceiver) then converts the radio signals transmitted from the receptor/transmitter unit in the earset (headset) into audible amplified communication, allowing communication to the another individual who would in telephonic communication with a person using the present invention (The transceiver in the portable telephone unit is similar to the transceiver in the headset and performs accordingly [col. 3, lines 65 - 67, col. 4, lines 1 - 7, lines 66 - 67, col. 5, lines 1 - 11, col. 5, lines 56 - 67, col. 6, lines 1-4, Fig. 4b).

Response to Arguments

IV. Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

V. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDON J. MILLER whose telephone number is (571)272-7869. The examiner can normally be reached on Mon.-Fri. 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/
Supervisory Patent Examiner, Art Unit 2617

/Brandon J Miller/
Examiner, Art Unit 2617

February 27, 2009